

II. REMARKS

A. Introduction

The Office Action dated February 20, 1997 has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2-16 stand rejected under 35 U.S.C. § 112 second paragraph. Claims 2, 3, 5 and 7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Saeki. Claims 8-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Campbell et al.. Claims 4 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saeki et al. in view of Block et al.. Claims 2-16 stand rejected under the judicially created doctrine of non-obviousness non-statutory double patenting over the patented claims in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414.

Claims 2, 5, 8, 9, 13 and 14 has been amended. Claims 2-16 remain active in this application.

As to the paragraph numbered 2, applicants will address the art rejections of this Office Action. Applicants, however, traverse the assertion that a double patenting situation exists. The present application claims priority under 35 U.S.C. § 120 of the following applications:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No.</u>
08/113,329	August 30, 1993	Pending
08/056,501	May 3, 1993	5,335,277
07/849,226	March 10, 1992	5,233,654
07/588,126	September 25, 1990	5,109,414
07/096,096	September 11, 1987	4,965,825
06/829,531	February 14, 1986	4,704,725
06/317,510	November 3, 1981	4,694,490

As to the paragraph numbered 3, applicants acknowledge their duty to maintain a line of patentable demarcation between related applications. Assuming, arguendo, that substantially duplicate claims exist, the applicants intend to make a good faith effort to alert the PTO of any instances in which the PTO treats such claims inconsistently.

As to the paragraph numbered 4, applicants acknowledge and appreciate the examiner's concern over the use of alternative claim language. Applicants assert that they believe that the disclosure supports every possible embodiment or permutation that can be created using said language. During the prosecution of this application, applicants intend to ensure that the disclosure supports each possible embodiment or claimed using alternative claims.

As to the double patenting rejections, applicants' views are fully discussed in applicants' reply brief to the rejections in application number 08/113,329 which is herein incorporated by reference. Applicants also address this rejection in the present application.

As to the paragraph numbered 10, the Office Action states that "determination of a possible non-statutory double patenting rejection obvious-type in each of the related 327 applications over each other will be deferred until a later time." Applicants submit that the examiner and the PTO cannot defer further rejections to a later time. Every ground of rejection should be made in examiner's first Office Action. 37 CFR § 1.104(a) states that "[o]n taking up an application for examination . . . the examiner shall make a

thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect to both compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated." The MPEP states "[t]he examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before action is made." MPEP § 707.07, citing 37 CFR § 1.105. Finally, "[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available" "Where a major technical rejection is proper, it should be stated with full development of reasons rather than by mere conclusion coupled with some stereotyped expression." MPEP § 707.07(g). Applicants submit that the examiner has a duty to give each application a complete examination, to make rejections with specificity, and that not to defer rejections. For these reasons, applicants likewise traverse the rejection based on the "judicially created doctrine of double patenting over the claims of copending U.S. application 08/113,329 and the following [list of all applicants copending applications]." Applicants submit that this rejection, even if appropriately made with specificity, should be a provisional double patenting rejection. Applicants respectfully request that this rejection be withdrawn.

As to the grouping of paragraphs numbered 20, applicants acknowledge and appreciate the interviews provided by the PTO. Applicants also appreciate the detailed

description of the interviews provided in the Office Action. The Office Action states that "the Group would like to have a complete grouping of applications in a manner that was submitted earlier for only a portion of the total filings." Applicants note that based on the Office Actions received thus far, the PTO does not appear to be following the groupings applicants submitted previously. The order of examination of applicants' applications do not seem to have any correspondence to the groupings previously submitted. Applicants, therefore, will not supply further groupings. Applicants will, however, gladly supply further groupings if requested by the PTO for the purpose of following these groupings. Mr. Groody has confirmed in a telephone conversation between Mr. Groody and Mr. Scott that no more groupings need be sent.

In the interest of maintaining a clear record, applicants respectfully traverse the Office Action's interview summary statement that an offer was made to terminally disclaim the present application with the '81 or '87 patents. Rather, applicants respectfully submit that their offer was to disclaim a block of copending applications against one another, provided their issue date was in close enough proximity so as not to result in unnecessarily great losses in patent term duration.

B. Pending Claims in View of the Applied Art

1. 35 U.S.C. § 112 Rejections

a. General remarks

The Office Action rejects all claims in the present application under 35 U.S.C. section 112, second paragraph. The Office Action states that the "examiner is not certain that the meets [sic] and bounds of these claims can be determined because of the

language in the disclosure and claims.” It further states that “[a]pplicants are being requested to reference the claim limitations in this application to the disclosure so that the meets [sic] and bounds of these claims can be properly considered.” Applicants traverse this rejection and submit that applicants have no duty to comply with this requirement. MPEP § 2111 states that “[d]uring patent examination, the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification.’” Also, it is only “when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language.” MPEP § 2111.01. The examiner has the responsibility of reading the specification to determine the meaning of terms in the claims of the application.

However, in order to advance the prosecution of the present application, applicants shall provide a summary of the pertinent disclosure including reference to examples supporting the claimed subject matter. Applicants shall provide citations to the ‘81 case supporting the pending claims, as well as a cross-reference to corresponding sections of the ‘87 specification. The present application asserts priority on the disclosure of the ‘81 case, filed on November 3, 1981, application no. 317,510, and issued September 15, 1987, as U.S. Pat. No. 4,694,490. The disclosure of the ‘81 case is generally addressed to apparatus and methods for automatically controlling the transmission and presentation of information programming, including the application of embedded signaling for a number of functions, including the control over decryption and access, monitoring of usage/availability, control of external equipment, coordination of multiple broadcasts, automated compilation and collection of billing data, and generation and presentation of combined media presentations of broadcast and locally-generated user specific content. (U.S. Pat. No. 4,694,490, Abstract; col. 3 line 29 to col. 5 line 27). The priority disclosure further discusses coordination and control

of programming at several levels of the communications chain, including transmission stations, intermediate transmission stations, and receiver stations.

Regarding the present application, claim 2 specifically, and all other claims generally are supported in applicants' U.S. Pat. No. 4,694,490, col. 18, line 42 through col. 20, line 68, col. 15, lines 20-25, and col. 8, line 20 through col. 10, line 13¹.

Specifically, regarding claim 5, see especially applicants' U.S. Pat. No. 4,694,490, col. 15, line 26 through col. 17, line 33. Regarding claims 9 and 13, see especially applicants' U.S. Pat. No. 4,694,490, col. 10, line 14 through col. 12, line 67. Regarding claim 14, see especially applicants' U.S. Pat. No. 4,694,490, col. 9, lines 31-33, col. 10, line 14 through col. 12, line 67, and col. 19, line 5 through col. 20, line 68. The foregoing is intended to be exemplary only and in no way to limit the claimed invention to the cited passages.

Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter. Applicants will provide additional specification support in their detailed response to the Examiner's specific rejections provided infra.

2. 35 U.S.C. § 102 Rejections

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1990) (en banc), cert denied 500 U.S. 904 (1991). The prior art must disclose each element of the claimed invention arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452,

¹ See also, applicants' 1987 specification, pages 311-312, pages 28-69, 516-557.

221 USPQ 481 (Fed. Cir. 1984). The Office Action fails to make a proper rejection for anticipation as it fails to identify in the cited references each element of the claims in the present application.

As to paragraph 17, applicants respectfully traverse the 35 U.S.C. § 102(e) rejection of claims 2, 3, 5 and 7 as being anticipated by Saeki.

Regarding claim 2, applicants submit that Saeki does not disclose the limitation in claim 2 of receiving from an input device a set of information collection parameters. The selections entered on the keyboard in Saeki do not meet this limitation. The keyboard in Saeki is used at the terminal unit to request video data signals. The request is received at the center and then the corresponding video signals are sent to the terminal unit. The video data signal selection in Saeki is not a set of information collection parameters as recited in claim 2.

Further, applicants submit that Saeki does not disclose the limitation in claim 2 of generating a query from a set of information collection parameters at a receiver station. As stated, the request made at the keyboard in Saeki is sent to the center and the corresponding video data signals are then sent to the terminal. Saeki does not disclose that a query is generated from the request. Saeki does not disclose or suggest generating a query from a set of information collection parameters.

Applicants submit that claim 2 is not anticipated by Saeki. As to claim 3, applicants submit that for at least the same reasons discussed regarding claim 2, Saeki does not disclose the limitations in claim 3. Applicants submit that claim 3 is patentable at least by virtue of its dependence from independent claim 2. Applicants respectfully request that these rejections be withdrawn.

Regarding claim 5, applicants submit that Saeki does not disclose the limitation in claim 5 of providing operating instructions or executable code to a plurality of receiver stations from a plurality of data sources. Saeki discloses a center which

transmits video data signals to a terminal upon receiving a request for the specific video data signals from the terminal. Saeki does not disclose or suggest providing operating instructions to a plurality of receiver stations. Saeki does not disclose or suggest providing executable code to a plurality of receiver stations. Saeki discloses one center receiving requests from and sending video data signals to several terminal units. Saeki, however, does not disclose multiple centers receiving requests from and sending video data signals to several terminal units. Saeki does not disclose providing operating instructions or executable code to a plurality of receiver stations from a plurality of data sources.

Applicants submit that claim 5 is not anticipated by Saeki. As to claim 7, applicants submit that for at least the same reasons discussed regarding claim 5, Saeki does not disclose the limitations in claim 7. Applicants submit that claim 7 is patentable at least by virtue of its dependence from independent claim 5. Applicants respectfully request that these rejections be withdrawn.

As to paragraph 18, applicants respectfully traverse the 35 U.S.C. § 102(e) rejection of claim 8-16 as being anticipated by Campbell.

Regarding claim 8, applicants submit that Campbell does not disclose the limitation in claim 8 of programming a computer at a receiver station to store a portfolio of data that designate a plurality of personal interests of a subscriber. Campbell discloses that the text formatter in the headend transmitter station can receive data from a wide variety of sources such as weather, news, and stock. However, these items in Campbell do not meet the limitation of a portfolio of data that designate a plurality of personal interests of a subscriber as recited in claim 8. Also, Campbell does not disclose that information from sources such as weather, news, and stock are stored at a receiver station.

Further, applicants submit that Campbell does not disclose the limitation in claim 8 of querying a transmitter station for data of programming of interest. Campbell discloses transmitting television programming to a receiver station where the receiver station has a converter that determines if the receiver station is allowed access to the transmitted programming. Campbell does not disclose or suggest that the headend transmitter is queried for data of programming of interest.

Applicants submit that claim 8 is not anticipated by Campbell. Applicants respectfully request that this rejection be withdrawn.

Regarding claim 9, applicants submit that Campbell does not disclose the limitation in claim 9 of receiving at a transmitter station downloadable code which is effective at a receiver station to store operating instructions at a storage device associated with a processor. As previously stated, Campbell discloses transmitting television programming to a receiver station where the receiver station has a converter that determines if the receiver station is allowed access to the transmitted programming. The event enable word in figure 11 of Campbell, and referenced in the Office Action, does not meet the limitation in claim 9 of operating instructions. The event enable word in figure 11 of Campbell is used to determine if the receiver station is allowed access to the transmitted television programming. The event enable word in figure 11 of Campbell is not downloadable code. The event enable word in figure 11 of Campbell is not operating instructions as recited in claim 9. Campbell does not disclose or suggest receiving at a transmitter station downloadable code which is effective at a receiver station to store operating instructions at a storage device associated with a processor.

Further, Campbell does not disclose the limitation in claim 9 of receiving one or more control signals at a transmitter station that operate to execute downloadable code. The enable codes in figure 11 of Campbell do not meet the limitation of control signals

in claim 9. The enable codes in figure 11 of Campbell do not meet the limitation of downloadable code. Campbell does not disclose or suggest receiving one or more control signals at a transmitter station that operate to execute downloadable code.

Applicants submit that claim 9 is not anticipated by Campbell. As to claims 10-12, applicants submit that for at least the same reasons discussed regarding claim 9, Campbell does not disclose the limitations in claims 10-12. Applicants submit that claims 10-12 are patentable at least by virtue of their dependence from independent claim 9. Applicants respectfully request that these rejections be withdrawn.

Regarding claim 13, applicants submit that Campbell does not disclose the limitation in claim 13 of storing data at said remote data source. The data from weather, news, stock, etc. that the headend transmitter receives in Campbell does not meet this limitation in claim 13. The headend in Campbell is a transmitter station, not a remote data source. Also, Campbell does not disclose that the data from weather, news, stock, etc. is stored.

Further, applicants submit that Campbell does not disclose the limitation in claim 13 of receiving at a remote data source a query for a first function or a record evidencing availability, use, or usage of a second function from a receiver station. The user ordering a pay-per-view movie in Campbell does not meet this limitation. Ordering a pay-per-view movie is not receiving at a remote data source a query for a first function. A movie is not a function. Also, ordering a pay-per-view movie is not receiving at a remote data source a record evidencing availability, use, or usage of a second function from a receiver station.

Applicants submit that claim 13 is not anticipated by Campbell. Applicants respectfully request that this rejection be withdrawn.

Regarding claim 14, applicants submit that Campbell does not disclose the limitation in claim 14 of receiving an instruct signal at an origination transmitter station

and delivering the instruct signal to an origination transmitter, the instruct signal being effective at a receiver station to store operating instructions at a storage device associated with a processor. The channel control word in Campbell, and referenced in the Office Action does not meet the limitation in claim 14 of an instruct signal. The channel control word in Campbell is used at the receiver station to determine if the receiver station is allowed access to the transmitted television programming. The channel control word in Campbell does not actively initiate anything or cause some activity to occur. Also, the channel control word in Campbell is not effective at a receiver station to store operating instructions at a storage device associated with a processor. Campbell does not disclose or suggest operating instructions. The channel control word in Campbell is not effective at a receiver station to store anything.

Applicants submit that claim 14 is not anticipated by Campbell. As to claims 15 and 16, applicants submit that for at least the same reasons discussed regarding claim 14, Campbell does not disclose the limitations in claims 15 and 16. Applicants submit that claims 15 and 16 are patentable at least by virtue of their dependence from independent claim 14. Applicants respectfully request that these rejections be withdrawn.

3. 35 U.S.C. § 103 Rejections

As to the 35 U.S.C. § 103 rejections for obviousness, the applicants traverse these rejections as being based on impermissible hindsight. That is, the Office Action's rejection under 35 U.S.C. § 103 is merely the teachings of applicants claimed invention against the applicants, a practice repeatedly held to violate obviousness requirements under §103. There must be a reason or suggestion in the art for combining the references, other than the knowledge obtained from applicants' disclosure. In re Dow Chemical, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) (citing Interconnect Planning Corporation v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985)), ACS Hospital Systems, *supra*,

at 932. The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art itself suggests the desirability of the modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). The Federal Circuit has, on numerous occasions made this point clear. For example, the court stated in ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984) that:

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Systems, at 932-33. Since the Office Action employs references that, arguendo, disclose disparate aspects of the present invention and does not employ references to show that the cited prior art itself suggests the plucking of one limitation from one reference and another limitation from another reference, accordingly the applicants assert that the Office Action fails to meet this burden of establishing a prima facie case for obviousness.

As to paragraph 19, applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 4 and 6 as being unpatentable over Saeki et al. in view of Block et al..

Regarding claim 4, applicants submit that for at least the same reasons discussed in response to the 35 U.S.C. section 102 rejection regarding claim 2, Saeki does not disclose the limitations in claim 4. Applicants submit that claim 4 is patentable at least by virtue of its dependence from independent claim 2.

Further, applicants submit that there would be no motivation for one skilled in the art to combine the teachings of Saeki with the teachings of Block. Saeki discloses a CATV system. Block, however discloses the use of telephone lines for monitoring information regarding billing for viewed television programs. In both cases, information is being sent back to the transmission center or transmitter station.

Applicants submit that one using a CATV closed system would not be motivated to combine this with the use of a much slower and noisier telephone line system when use of the telephone line system results in no substantial improvement over the existing cable system. Applicants submit that there would be no motivation for one skilled in the art to combine the Saeki reference with the Block reference.

Applicants submit that neither Saeki nor Block, taken alone or in combination, disclose or suggest the limitations in claim 4, nor would the limitations in claim 4 be obvious from the teachings of Saeki or Block. Applicants respectfully request that this rejection be withdrawn.

Regarding claim 6, applicants submit that for at least the same reasons discussed in response to the 35 U.S.C. section 102 rejection regarding claim 5, Saeki does not disclose the limitations in claim 6. Applicants submit that claim 6 is patentable at least by virtue of its dependence from independent claim 5.

As stated previously, applicants submit that there would be no motivation for one skilled in the art to combine the teachings of Saeki with the teachings of Block. Saeki discloses a CATV system. Block, however discloses the use of telephone lines. In both cases, information is being sent back to the transmission center or transmitter station. Applicants submit that one using a CATV closed system would not be motivated to combine this with the use of a much slower and noisier telephone line system when use of the telephone line system results in no substantial improvement over the existing cable system. Applicants submit that there would be no motivation for one skilled in the art to combine the Saeki reference with the Block reference.

Applicants submit that neither Saeki nor Block, taken alone or in combination, disclose or suggest the limitations in claim 6, nor would the limitations in claim 6 be obvious from the teachings of Saeki or Block. Applicants respectfully request that this rejection be withdrawn.

C. Response To Rejection Based On MPEP Section 804 (II)(B)(2)

As to the Office Action's rejection of applicants' claim under a non-statutory non-obvious type of double patenting, applicants strongly traverse examiner's double patenting rejection on three separate grounds. First, the applied section, MPEP § 804 (II)(B)(2), defining non-statutory non-obvious double patenting, is predicated on an improper reading of case law, and, thus, the resultant rejection constitutes an ultra vires action by the PTO. Second, the PTO's present rejection based on MPEP section 804 (II)(B)(2) is no more than an application of the now discredited late claiming doctrine. Third, assuming arguendo that the non-statutory non-obvious double patenting rejection set forth in MPEP § 804 (II)(B)(2) is a proper reading of case law, and not in violation of the Administrative Procedure Act, this class of rejection does not apply to the factual situation of the present application. Applicants' arguments for each contention are addressed in applicants' reply brief for application 08/113,329 and are herein incorporated by reference.

1. The Claims in the Present Application are Distinct From the Claims in the Patents

As an initial matter, the examiner's rejection of the present application under the Schneller double patenting theory based on Harvey U.S. Patents 4,694,490 and 4,704,725 is improper because the present application does not claim the benefit of those applications under 35 U.S.C. § 120. Thus, there could never have been a basis for

claiming the present subject matter in those applications. Therefore, the rejection based on Harvey U.S. Patents 4,694,490 and 4,704,725 should be withdrawn.

However, the PTO fails to specifically identify all claims from cited Harvey patents that cover specific claims in the present application. Rather, the Office Action references "representative claims" from patents and the present application. The Office Action does not cite specific elements from claims in a patent covering specific elements in claims in the application. In fact, the Office Action acknowledges that the patent claims and application claims are directed to different elements, but states that this "does not prohibit this rejection if there is common or interrelated subject matter recited." The Office Action then references Schneller in support of this erroneous statement, not supported by Schneller.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action states that the independent and distinct standard was the main factor in the Schneller court's determination that the double patenting rejection should be affirmed. The Office Action has misinterpreted this phrase. This phrase means independent 'or' distinct. MPEP (6th ed.) § 802.01. The MPEP defines independent as meaning "that there is no disclosed relationship between the two or more subjects disclosed" and that they are not connected. The MPEP defines the term distinct as meaning that "two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed" Two or more subjects cannot then be unrelated, independent, and also related, and thus distinct. Analyzing the PTO's cited representative claims referenced in the Office Action, the claims of the

present application are clearly distinct from the claims in the patents and therefore the claims in the present application are patentable. Applicants respectfully request that these rejections be withdrawn.

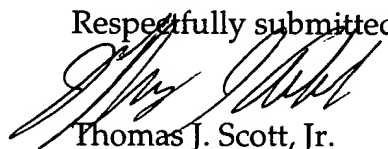
III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections are rejections have been overcome and/or rendered moot. Further, that all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

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